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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,209	12/08/2003	Amy L. Rubinstein	26007.0003U2	4631

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EXAMINER

NOBLE, MARCIA STEPHENS

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/730,209

Applicant(s)

RUBINSTEIN ET AL.

Examiner

Marcia S. Noble

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

1. Claims 1-35 are pending.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a method of identifying an anti-angiogenic compound comprising containing a transgenic zebrafish that expresses a reporter protein in blood vessels with a test compound and determining if reduces blood vessel growth compared to controls, classified in class 800, subclass 3.
- II. Claims 6-10, drawn to a method of identifying an pro-angiogenic compound comprising containing a transgenic zebrafish that expresses a reporter protein in blood vessels with a test compound and determining if increases blood vessel growth compared to controls, classified in class 800, subclass 3.
- III. Claims 11-15, drawn to method of identifying a blood vessel related gene that is involved in blood vessel growth comprising a zebrafish with an altered blood vessel related gene with that of a control and determine if the blood vessel related gene is involved in blood vessel growth, classified in class 800, subclass 3.
- IV. Claims 15-20, drawn to a method of identifying a pro-angiogenic blood vessel related gene that modulates an anti-angiogenic compound in genetically altered zebrafish, classified in class 800, subclass 3.

- V. Claims 21-25, drawn to a method of identifying a anti-angiogenic blood vessel related gene that modulates an pro-angiogenic compound in genetically altered zebrafish, classified in class 800, subclass 3.
- VI. Claims 26-30, drawn to a method of identifying a pro-angiogenic compound that modulates the effects of an anti-angiogenic blood vessel relates gene in genetically altered zebrafish, classified in class 800, subclass 3.
- VII. Claims 31-35, drawn to a method of identifying a anti-angiogenic compound that modulates the effects of an pro-angiogenic blood vessel relates gene in genetically altered zebrafish, classified in class 800, subclass 3.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, VI, VII and III-V are distinct. Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different groups of inventions are distinct because they are identifying structural unrelated products a gene and a compound. The methods of identifying genes involve altering a blood vessel gene and monitoring the difference, whereas the inventions identifying a compound are adding an agent to a zebrafish animal model an measuring the effects on blood vessel growth. Therefore these different groups of invention have different method steps.

3. Inventions I, VII and II, VI are distinct. Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different groups of inventions are distinct because they are identifying compounds with different physiological effects (ie-reduction or increase in blood vessel growth).

4. Inventions III and IV, V are distinct. Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions, the method of IV and V have different steps than the method of III that does not involve contacting the zebrafish model with a compound as is the case in IV and V.

5. Inventions IV and V are distinct. Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are distinct because they are identifying compounds and genes with different physiological effects (ie-reduction or increase in blood vessel growth).

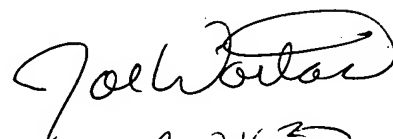
Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcia S. Noble whose telephone number is (571) 272-5545. The examiner can normally be reached on M-F 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marcia S. Noble

  
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